

PATENT COOPERATION TREATY

RECEIVED

From the INTERNATIONAL SEARCHING AUTHORITY

JAN 14 2002

To: HOWARD, L. SOBELMAN
 SNELL & WILMER LLP.
 ONE ARIZONA CENTER
 400 EAST VAN BUREN
 PHOENIX, ARIZONA 85004-2202

PCT

SNELL & WILMER, LLP

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL SEARCH REPORT
OR THE DECLARATION

(PCT Rule 44.1)

Date of Mailing (day/month/year) 10 JAN 2002	
Applicant's or agent's file reference 40655.1316	FOR FURTHER ACTION See paragraphs 1 and 4 below
International application No. PCT/US01/19219	International filing date (day/month/year) 18 APRIL 2001
Applicant AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC.	

1. The applicant is hereby notified that the international search report has been established and is transmitted herewith.

Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

When? The time limit for filing such amendments is normally 2 months from the date of transmittal of the international search report; however, for more details, see the notes on the accompanying sheet.

Where? Directly to the International Bureau of WIPO
 34, chemin des Colombettes
 1211 Geneva 20, Switzerland
 Facsimile No.: (+41-22) 740.14.55

For more detailed instructions, see the notes on the accompanying sheet.

2. The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3. **With regard to the protest** against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

- the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.
- no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Further action(s):** The applicant is reminded of the following:

Shortly after **18 months** from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in rules 90 bis 1 and 90 bis 3, respectively, before the completion of the technical preparations for international publication.

Within **19 months** from the priority date, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later).

Within **20 months** from the priority date, the applicant must perform the prescribed acts for entry into the national phase before all designated Offices which have not been elected in the demand or in a later election within 19 months from the priority date or could not be elected because they are not bound by Chapter II.

Name and mailing address of the ISA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703) 305-3230	Authorized officer EDWARD R. OSIMANO <i>James R. Matthews</i> Telephone No. (703) 305-9783
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Form PCT/ISA/220 (July 1998)*

(See notes on accompanying sheet)

PATENT COOPERATION TREATY

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INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference 40655.1316	FOR FURTHER ACTION	see Notification of Transmittal of International Search Report (Form PCT/ISA/290) as well as, where applicable, item 5 below.
International application No. PCT/US01/12219	International filing date (<i>day/month/year</i>) 13 APRIL 2001	(Earliest) Priority Date (<i>day/month/year</i>) 14 APRIL 2000
Applicant AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC.		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 3 sheets.

It is also accompanied by a copy of each prior art document cited in this report.

1. **Basis of the report**

- a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 28.1(b)).
- b. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international search was carried out on the basis of the sequence listing:
 - contained in the international application in written form.
 - filed together with the international application in computer readable form.
 - furnished subsequently to this Authority in written form.
 - furnished subsequently to this Authority in computer readable form.
 - the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the
 - the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

2. **Certain claims were found unsearchable** (See Box I).

3. **Unity of invention is lacking** (See Box II).

4. With regard to the **title**,

- the text is approved as submitted by the applicant.
- the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

- the text is approved as submitted by the applicant.
- the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. The figure of the **drawings** to be published with the abstract is Figure No. _____

- as suggested by the applicant.
- because the applicant failed to suggest a figure.
- because this figure better characterizes the invention.

None of the figures.

INTERNATIONAL SEARCH REPORT

International application No.
PCT/US01/12219**A. CLASSIFICATION OF SUBJECT MATTER**

IPC(7) :G06F 17/60

US CL :705/14

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : 705/1, 14, 26, 27, 400

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched
NONE

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)

NONE

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	US 5,537,314 A (KANTER) 16 July 1996, see abstract.	1-8, 11, 13-24, 27-33 & 37-41
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Y		9, 10, 12, 25, 26 & 34-36
X	FALLON: "UK Retailers' Loyal Customer 'Card Wars' Prove Costly (Most major retailers in the UK have grown their sales over the past 2 years by launching loyalty-card programs)"; Supermarket News, 05 May 1997; vol. 47, no. 18, page 57, see abstract.	1-8, 11, 13-24, 27-33 & 37-41
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Y		9, 10, 12, 25, 26 & 34-36

 Further documents are listed in the continuation of Box C.

See patent family annex.

*	Special categories of cited documents:	"T"	later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"A"	document defining the general state of the art which is not considered to be of particular relevance	"X"	document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"E"	earlier document published on or after the international filing date	"Y"	document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"L"	document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	"g"	document member of the same patent family
"O"	document referring to an oral disclosure, use, exhibition or other means		
"P"	document published prior to the international filing date but later than the priority date claimed		

Date of the actual completion of the international search

05 AUGUST 2001

Date of mailing of the international search report

10 JAN 2002

Name and mailing address of the ISA/US
Commissioner of Patents and Trademarks
Box PCT
Washington, D.C. 20231
Facsimile No. (703) 305-3230

Authorized officer

EDWARD R COIMANO

Telephone No. (703) 305-9783

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US01/12219

C (Continuation). DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A, P	WO 01/01282 A2 (ANDERSON et al) 04 January 2001, see abstract.	1-41
A, P	US 6,222,914 B1 (MCMULLIN) 24 April 2001, see abstract.	1-41

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty and of the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

In these Notes, "Article", "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

What parts of the international application may be amended?

The claims only.

The description and the drawings may only be amended during international preliminary examination under Chapter II.

When? Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been filed, see below.

How? Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

What documents must/may accompany the amendments?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confounded with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

PATENT COOPERATION TREATY

RECEIVED

MAR 18 2002

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To: HOWARD, I. SOBELMAN
SNELL & WILMER LLP.
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX, ARIZONA 85004-2202

PCT SNELL & WILMER

WRITTEN OPINION

(PCT Rule 66)

Date of Mailing
(day/month/year) **13 MAR 2002**

Applicant's or agent's file reference 40655.1316		REPLY DUE within TWO months from the above date of mailing
International application No. PCT/US01/19219	International filing date (day/month/year) 13 APRIL 2001	Priority date (day/month/year) 14 APRIL 2000
International Patent Classification (IPC) or both national classification and IPC IPC(7): G06F 17/60 and US Cl.: 705/14		
Applicant AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC.		

1. This written opinion is the first _____ (first, etc.) drawn by this International Preliminary Examining Authority.

2. This opinion contains indications relating to the following items:

- I Basis of the opinion
- II Priority
- III Non-establishment of opinion with regard to novelty, inventive step or industrial applicability
- IV Lack of unity of invention
- V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement
- VI Certain documents cited
- VII Certain defects in the international application
- VIII Certain observations on the international application

3. The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also For an additional opportunity to submit amendments, see Rule 66.4. For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis. For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 14 AUGUST 2002

Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703) 305-8280	Authorized officer <u>JR</u> EDWARD R COSIMANO James R. Matthews Telephone No. (703) 305-9783
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I. Basis of the opinion**1. With regard to the elements of the international application:***

the international application as originally filed

the description:

pages 1-24, as originally filed

pages NONE, filed with the demand

pages NONE, filed with the letter of _____

the claims:

pages 25-33, as originally filed

pages NONE, as amended (together with any statement) under Article 19

pages NONE, filed with the demand

pages NONE, filed with the letter of _____

the drawings:

pages 1-17, as originally filed

pages NONE, filed with the demand

pages NONE, filed with the letter of _____

the sequence listing part of the

description: NONE, as originally filed

pages NONE, filed with the demand

pages NONE, filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language _____ which is:

the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).

the language of publication of the international application (under Rule 48.3(b)).

the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the written opinion was drawn on the basis of the sequence listing:

contained in the international application in printed form.

filed together with the international application in computer readable form.

furnished subsequently to this Authority in written form.

furnished subsequently to this Authority in computer readable form.

The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

the description, pages None

the claims, Nos. None

the drawings, sheets/fig None

5. This opinion has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed".

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. statement

Novelty (N)	Claims <u>9, 10, 12, 25, 26 & 34-36</u>	YES
	Claims <u>1-8, 11, 13-24, 27-33 & 37-41</u>	NO
Inventive Step (IS)	Claims <u>None</u>	YES
	Claims <u>1-41</u>	NO
Industrial Applicability (IA)	Claims <u>1-41</u>	YES
	Claims <u>None</u>	NO

2. citations and explanations

1. Claims 1-8, 11, 13-24, 27-33 & 37-41 lack novelty under PCT Article 33(2) as being anticipated by either Kanter ('5,537,314) or Fallon.

1.1 In regard to claims 1-8, 11, 13-24, 27-33 & 37-41, either Kanter ('314) or Fallon disclose a system in which a participant that has been registered in a loyalty program may earn loyalty points through the loyalty program by complying with the rules for earning loyalty points. When the participant wishes to redeem the accumulated loyalty points in order to make a purchase from a merchant/vendor, then the participant would access the loyalty program's system using a network. If the participant has been verified, then the loyalty points for the participant are retrieved from the loyalty program's database. Further, if the participant has sufficient loyalty points, then at least some of the retrieved accumulated loyalty points are converted into either an award certificate or a cash value that may be applied by the participant towards the purchase price of a purchase being made by the participant. Finally the associated accounts are updated to reflect the transaction.

2. Claims 9, 10, 12, 25, 26 & 34-36 lack an inventive step under PCT Article 33(5) as being obvious over either Kanter ('5,537,314) or Fallon.

2.1 In regard to claims 9, 10, 12, 25, 26, 34 & 35, neither Kanter ('314) nor Fallon disclose the type of communications network used, however, since these systems do in fact require the use of a communications network, it would have been obvious to one of ordinary skill at the time the invention was made that any suitable communications network may be used in the systems of either Kanter ('314) or Fallon to accomplish the required exchanges of information.

2.1.1 In regard to claim 36, it is noted that the communication network used in either Kanter ('314) or Fallon could be the internet.

(Continued on Supplemental Sheet.)

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

- ✓ 1. The drawings are objected to under PCT Rule 66.2(a)(iii) as containing the following defect(s) in the form or content thereof:

1.1 as can be seen in figs. 13 & 14 and as disclosed:

A) in the description of fig. 1, between page 6, line 22, and page 14, line 2; and

B) at pages 16-23;

in fig. 1, the box designated by reference number 5 and labeled "PARTICIPANT" should be labeled as --MERCHANT--.

✓ 1.2 the drawings lack fig. "D" as disclosed in the paragraph bridging pages 14-15, and in particular at:

A) page 15, line 2; and

B) page 19, line 2.

✓ 1.3 as fig. 14 is disclosed between page 22 and page 24, and in particular at page 23, line 18, fig. 14 lacks reference number 312.

✓ 1.4 as can be seen in fig. 14 in the upper left near device 20 and in the lower left near merchant 5, fig. 14 uses reference number 302 twice to designate different features of the invention, note the description of fig. 14 between page 22 and page 24.

- ✓ 2. The description is objected to as containing the following defect(s) under PCT Rule 66.2(a)(iii) in the form or contents thereof:

- / 2.1 The use of various trademark(s) at pages 6-9, 11, 13-14 has been noted in this application. Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

/ 2.1.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

✓ 2.2 the disclosure lacks an explicit reference to reference numbers 31 & 32 of fig. 4 in the paragraph bridging pages 14-15, as fig. 4 is described.

(Continued on Supplemental Sheet.)

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 10

TIME LIMIT:

The time limit set for response to a Written Opinion may not be extended. 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.

V. 2. REASoNED STATEMENTS - CITATIONS AND EXPLANATIONS (Continued):

2.2 In regard to claim 12, neither Kanter ('314) nor Fallon disclose that a third party operates the loyalty program, however, since these systems are not implemented by the merchant/vendor, it would have been obvious to one of ordinary skill at the time the invention was made that loyalty programs of either Kanter ('314) or Fallon are operated by a third party.

----- NEW CITATIONS -----

NONE

VII. CERTAIN DEFECTS IN THE APPLICATION (Continued):

2.3 since the drawings lack fig. "D" as disclosed in the paragraph bridging pages 14-15, and in particular at page 15, line 2, at page 15, line 2, "D" should be --12D--.

2.4 as can be seen in fig. 7, in the paragraph at page 16, lines 10-19, "In an exemplary ... repeated use information", at page 16, line 11, "61" should be --62--.

2.5 as can be seen in fig. 7, in the paragraph at page 16, lines 10-19, "In an exemplary ... repeated use information", at page 16, line 12, "62" should be --61--.

2.6 the disclosure lacks an explicit reference to reference numbers 71 & 72 of fig. 9 in the paragraph at page 16, lines 10-19, as fig. 9 is described.

2.7 applicant should update the application information at pages 16 & 20 with the current status of the referenced application.

2.8 since the drawings lack fig. "D" as disclosed in the paragraph beginning at page 19, line 3, and in particular at page 19, line 3, "D" should be --12D--.

2.9 the disclosure lacks an explicit reference to reference number 81 of fig. 12A in the paragraph at page 19, lines 3-33, as fig. 12A is described.

2.10 the disclosure lacks an explicit reference to each feature of the invention designated by reference numbers 115, 116, 117 & 118 of fig. 12B in the paragraph at page 19, lines 3-33, as fig. 12B is described.

2.11 as can be seen in fig. 12B, in the paragraph at page 19, lines 3-33, at page 19, line 14, "115" should be --116--.

2.12 the disclosure lacks an explicit reference to reference number 303 (in the upper left near device 20) of fig. 14, as fig. 14 is described between pages 22 and page 24.